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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/725,894 | 11/30/2000 | Satoshi Shimura | PNDF-00163 | 9262 |
| 21254 | 7590 | 03/01/2004 | EXAMINER | |
| MCGINN & GIBB, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817 | | | EL HADY, NABIL M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2154 | 7 |

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,894

Applicant(s)

SHIMURA ET AL.

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5 & 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-11 are pending in this application.
2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show details of the circled branched process 3 in the flow charts of Figs. 2 and 5; details of the circled branched process 12 in the flow charts of Figs. 8 and 9; and details of the circled branched process 33 in the flow charts of Fig. 12. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The disclosure is objected to under 37 CFR 1.71, as being so incomprehensible as to preclude a reasonable search of the prior art by the examiner. For example, the following items are not understood: page 5, lines 1-5.

Applicant is required to submit an amendment, which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following phrases are not clearly understood:

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a) " for obtaining content demanded by the portable terminal to obtain", claim 1, lines 2-3;

b) "of every information amount", claim 1, line 11;

c) "by transmitted divided content unit", claim 1, lines 14-15;

B. The following terms lack antecedent basis:

a) "the other contents", claim 1, line 13;

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 4, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art, hereafter "AAPA" in view of Iwata (JP 11175426A).

8. As to claim 1, AAPA discloses the invention substantially as claimed including a content supply apparatus, interposed between a portable terminal and a content server, for obtaining content demanded by the portable terminal to obtain and sending to the portable terminal (page 1, lines 12-23), comprising: a content hold means for holding the content obtained from the content server (page 1, lines 18-20, and transmitting to the portable terminal of every information amount that can be displayed by the portable terminal (page 1, lines 21-25); and a prefetcher means for prefetching the other contents referred from said divided content, by

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transmitted divided content unit, from the content server, and storing in said content hold means (prefetch technology, page 2, line 10 to page 3, line 15) .

9. AAPA does not disclose a divided content supply means for obtaining the content demanded by the portable terminal from said content hold means if the same exists in said means, and from the content server if the same does not exist, and transmitting to the portable terminal by divided content unit of every information amount that can be displayed by the portable terminal. Iwata, on the other hand, discloses a divided content supply means for obtaining the content demanded by the portable terminal from said content hold means if the same exists in said means, and from the content server if the same does not exist, and transmitting to the portable terminal by divided content unit of every information amount that can be displayed by the portable terminal (abstract, and Fig. 1). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of AAPA and Iwata because Iwata's divided content supply means would enable AAPA's system of utilizing the service provided by the content server adapted to a portable terminal , reduces forwarding time since the size of the divided contents is smaller than the original content, and reduces communication cost and network load.

10. As to claim 3, AIAA discloses a prefetch list creation section for detecting link information to the other contents contained in the divided content transmitted by said divided content supply means to the portable terminal for establishing a prefetch list and delivering to said prefetcher means (inherent in page 3, lines 12-22).

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11. As to claim 4, AIAA discloses said prefetcher means prefetches according to the prefetch list transmitted from the portable terminal (inherent in page 2, lines 20-27)

12. As to claim 5, AIAA and Iwata do not necessarily disclose said prefetcher means storing a message matching off against the concerned content URI for any unavailability reason, and transmitting the message to the portable terminal. Official notice is taken that the both the concept and advantages of providing such unavailability message is well known and expected in the art. It would have been obvious to one skilled in the art at the time of the invention to convey a message to the user of the portable terminal to answer the user's request of one of the prefetched item.

13. As to claim 7, the claim is rejected for the same reasons as claim 1 above. In addition, a machine readable recording media recording a program for functioning a computer constituting a content supply apparatus, interposed between a portable terminal and a content server, for obtaining content demanded by the portable terminal to obtain and sending to the portable terminal, as a content hold means, a divided content supply means, and a prefetcher means, is inherent in AIAA and Iwata disclosures.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art, hereafter "AAPA" in view of Iwata (JP 11175426A) as applied to claim 1 and further in view of Edwards et al. (WO 97/49044), hereafter « Edwards ».

15. Edwards et al. are cited by the applicant in IDS Paper No. 6 filed 7/21/2003.

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16. As to claim 2, AIAA and Iwata do not disclose a link information format conversion section for mutual conversion of URI format link information and ID number format link information. Edwards, on the other hand, discloses converting link information of URI format to ID number format and vice versa wherein, the divided content is transmitted to the portable terminal with ID number format and obtaining the corresponding URI format when the portable terminal demands to obtain content in ID number format (page 2, lines 11-26).). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of AAPA, Iwata, and Edwards because Edwards URI format/ID number format conversion would provide AAPA-Iwata system with a user interface in the portable terminal that is better suited to the user and the device of the portable terminal.

17. As to claim 6, 8-11, the claims would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. .

Arlitt et al. (US 6,272,598) ; Jiang et al. (US 6,385,641) ; Brown et al. (US 6,665,838); Crosskey et al. (US 6,035,281); Malkin et al. (US 6,085, 193) ; Cameal et al. (US 6,282,542) ; and Pirolli et al. (US 6,098,064).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 23, 2004



Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
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